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AND RELATED FEDERAL AND ITC LITIGATION



DOCKET NO: 7791-0081-25X

ATTN: APPLICATION BRANCH

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RECEIVED

AUG 4 2000

Group 2700

Re: Inventor: David ROCHON, et al.
Serial No.: 09/418,509
Filed: October 15, 1999
For: SYSTEM AND METHOD FOR
DELIVERING TARGETED...

SIR:

Attached hereto for filing are the following papers:

**Petition to Make Special
Information Disclosure Statement / PTO 1449
Cited References (10)**

Our check in the amount of **\$ 130** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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7791-0081-25X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

DAVID ROCHON ET AL.

SERIAL NO: 09/418,509



GROUP ART UNIT: 2761 (ANTICIPATED)

FILED: 10/15/99

: EXAMINER: POINVIL, F. (ANTICIPATED)

FOR: SYSTEM AND METHOD FOR
DELIVERING TARGETED
PRODUCT SAMPLES AND
MEASURING CONSUMER
ACCEPTANCE VIA A
COMPUTER NETWORK

RECEIVED
AUG 4 2000
Group 2700

PETITION TO MAKE SPECIAL (MPEP 708.02)

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

I. Basis for the Petition

Pursuant to MPEP 708.02, Section VIII, Revision February 2000, the Applicants
petition for a special status for this application.

**II. Requirement for Granting the Petition and Showing that the
Requirements for Granting the Petition Have Been Met**

The following subsections identify the requirements for the petition to be granted and
show that those requirements are met.

A. Submit Petition and Fee - MPEP 708.02, Section VIII(.A)

This petition is accompanied by the 37 CFR 1.17(i) petition fee.

B. Agree to an Election Without Traverse - MPEP 708.02, Section VIII(.B)

The Applicants agree that if the Examiner imposes a restriction requirement, the
Applicants will make an election without traverse.

**C. State that a Pre-examination Search was Made - MPEP 708.02,
Section VIII(.C)**

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A pre-examination search was made through class 705, subclasses 14 and 26, and also using EAST (Examiners' Automated Search Tool).

D. Submit Copies of Most Relevant References - MPEP 708.02, Section VIII(D)

The Applicants are submitting a PTO-1449 listing each of the references located in the pre-examination search.

E. Detailed Discussion Pointing Out How the Claimed Subject Matter is Patentable Over the References - MPEP 708.02, Section VIII(E)

The present claims are patentable since the references cited in the pre-examination search, taken alone or in combination, do not anticipate or suggest a computer network implemented method, system or program as defined by claim 1, including the following limitations:

- 1) transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;
- 2) transmitting a manufacturer's sample offer from the main computer over the computer network to the network address for the user's computer if the user's profile data meets user profile criteria associated with a manufacturer's sample offer for a sample of a product; and
- 3) generating instructions for providing the sample of the product to the user if the main computer receives a signal transmitted over the computer network indicating the user accepts the manufacturer's sample offer.

Claims 16 and 31 are system and computer program product analogs of claim 1, and define substantially the same limitations as claim 1, and contain system or program product

analog of the limitations (including (1), (2) and (3) above) defined by claim 1. The references from the pre-examination search, taken singularly or in any combination, do not anticipate and would not have suggested that subject matter. The following paragraphs discuss each reference identified by the search, and that no reference discloses the combination of limitations (1), (2) and (3).

U.S. Patent No. 5,227,874 to Von Kohorn teaches a method for measuring the effectiveness of stimuli on decisions of shoppers. Von Kohorn teaches that a person exposed to the stimulus of an advertisement receives tokens such as coupons when they respond via a response unit.¹ A computer network is not employed to broadcast the advertisements. Thus, Von Kohorn fails to teach or suggest a computer network implemented method, system or program having any of limitations (1), (2) and (3) above.

U.S. Patent No. 5,502,636 to Clarke teaches a personalized coupon generating and processing system. Clarke teaches offering coupons through cable and broadcast television advertising, and communicating responses through a 1-800 telephone number.² Clarke fails to teach or suggest a computer network implemented method, system or program having any of limitations (1), (2) and (3) above.

U.S. Patent No. 5,612,868 to Off et al teaches a method and apparatus for dispensing discount coupons. Off et al fails to teach or suggest a computer network implemented method, system or program having any of limitations (1), (2) and (3) above.

U.S. Patent No. 5,754,939 to Herz et al teaches a system for generation of user profiles for a system for customized electronic identification of desirable objects. Herz et al teaches locating news articles or coupons in electronic media.³ Herz et al fails to teach or

¹Von Kohorn, column 2 lines 45-64.

²Clarke, column 2 lines 36-47.

³Herz et al, column 60 lines 7-24.

suggest a computer network implemented method, system or program having limitations (2) or (3) above.

U.S. Patent No. 5,907,830 to Engel et al teaches a system for electronic coupon distribution. Engel et al teaches downloading coupons marked with the address of the client computer.⁴ Engel et al fails to teach or suggest a computer network implemented method, system or program having all of limitations (2) or (3) above.

U.S. Patent No. 5,916,024 to Von Kohorn teaches a system and method of playing games and rewarding successful players. Von Kohorn fails to teach or suggest a computer network implemented method, system or program having any of limitations (1), (2) and (3) above.

U.S. Patent No. 5,926,795 to Williams teaches a system and apparatus for dispensing coupons having selectively printed borders around preferred products. Williams fails to suggest a computer network implemented method, system or program having any of limitations (1), (2) and (3) above.

U.S. Patent No. 6,039,244 to Finsterwald teaches a method of building up a data bank containing customer data and/or for the organization of a rebate or coupon system. Finsterwald teaches that products to be sold are provided with an individual code, which the customer transmits along with his postal address or Internet address, by Internet or by telephone, enabling him to participate in a bonus program or enter a competition.⁵ Finsterwald fails to suggest a computer network implemented method, system or program having limitations (2) or (3) above.

⁴Engel et al, column 2 lines 30-41.

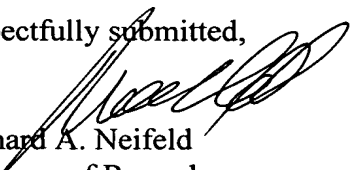
⁵Finsterwald, column 1 line 52- column 2 line2

U.S. patent No. 6,061,660 to Eggleston et al. teaches a system and method for incentive programs and award fulfillment. Eggleston et al. fail to suggest a computer network implemented method, system or program having limitations (2) or (3) above.

U.S. patent No. 6,075,971 to Williams et al. teaches a method and apparatus for providing and monitoring coupons via a network. Williams et al. fail to suggest a computer network implemented method, system or program having limitations (2) or (3) above.

III. Based on the above discussion, the present petition should be granted.

Respectfully submitted,


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